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EXAMINER
BERCH.M

ART UNIT	PAPER NUMBER
1611	

DATE MAILED: 04/24/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/932,834

Applicant(s)

Porubek

Examiner

Mark L. Berch

Group Art Unit

1611



☒ Responsive to communication(s) filed on 9/18/97

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-7 and 9-27 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7 and 9-27 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

Claims 1-7, 9-27 are rejected 35 USC 112, paragraph 1, for lack of enablement in terms of how to use. The reasoning was given previously in the Final Rejection, supplemented by remarks in the Advisory action.

Claims 1-7, 9-27 are rejected under 35 U.S.C. 112, paragraphs 1 and 2, as the claimed invention is not described, or is not described in such full, clear, and exact terms as to enable any person skilled in the art to make and use the same, and/or failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Specifically:

- ✓ 1. Even with the new convoluted  $R_7$  language in the Claim, the additions still constitute new matter. There is only the one Claim 14 species that applicants are entitled to for the dimethylaminocarbonyl choice, so that species should simply be put into claim 1. As the claim is currently written, the limitation on n, etc, only operates when "one"  $R_7$  is dimethylamino. If both are dimethylamino, the limitations don't apply.
- ✓ 2. The new  $R_7$  containing term heavily overlaps with the  $R_5$  containing term. For example, the  $m = 2$  choice is now superfluous.
- ✓ 3. The "alkyl" groups which have appeared in the third from last lines of Claim 1 and Claim 6 appear to be new matter. Where did these groups come from?
- ✓ 4. "Alkylthio" in the second to last line of Claims 1 and 6 lack description. The "thioalkoxy" could have been that, or it could have been mercaptoalkoxy; there is no way to know for sure which the specification originally intended.

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5. Similarly, the replacement of the original "carboxylic acid" (i.e.  $\text{RCO}_2\text{H}$ ) in claim 6 with "carboxy" similarly lacks description. While  $\text{RCO}_2\text{H}$  was clearly wrong, the "carboxy" is an arbitrary choice to replace it, since  $-\text{R}-\text{CO}_2\text{H}$  or even  $-\text{OC}(\text{O})\text{R}$  could have been what was intended.

6. Similarly, the "phenyl amino" in Claim 12 lacks description in the specification. "Benz" normally denotes a fused benzene ring, e.g. in benzimidazole.

7. Further, this choice isn't permitted by the main  $\text{R}_5$  definition anyhow.

8. What is the new "alkylsulfoxy" group in Claims 1 and 6?

9. Moreover, what is "alkylphospho"? Phospho is normally a prefix indicating the presence of the element phosphorous in some form.

10. The scope of "carbohydrate-moiety" as the second choice for  $\text{R}_4$  is entirely unclear. Does the "naturally occurring" modify this as well? What is its structure? How is the moiety formed?

11. The "cyclic" of Claim 10, line 2, has no antecedent basis in Claim 1.

12. The word "group" is presumably missing from the second line of Claim 10.

13. Claim 10, fifth from last line, last term has a substituent not permitted by Claim 1.

14. Likewise, the nicotinyl has a substituent (the phenyl) which isn't permitted on the heterocyclic ring.

15. Claim 22 does not make sense. "And" should be replaced by "or" since one or the other, but not both of these can be true.

16. When Q is substituted alkyl, substituted with what?

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17. Claim 26-7 have  $R_5$  as H, but that is not permitted by Claim 1.
18. The new version of Claim 14 has its numerals too small to be read.
19. The sixth species of Claim 14 has  $R_5$  as a substituted alkenyl, not provided for in Claim 1, and hence not having a disclosed utility.
20. The last two terms of claim 18 are indefinite for reasons given in point 18 of the Final Rejection.
21. Original point 20 remains. The problem was fixed for carbocyclic but not heterocyclic in Claims 1 and 20, and just the reverse in Claim 15.

The elimination of the methoxy as a choice for  $R_4$  and narrowing the carbocycle definition eliminates the art rejections.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718.

Mark L. Berch



Primary Examiner

Group 1610 - Art Unit 1611

April 21, 1998